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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,187	07/11/2001	Lee Soobok	PATL. P-001	8663
21121	7590	01/28/2005	EXAMINER	
OPPEDAHL AND LARSON LLP P O BOX 5068 DILLON, CO 80435-5068			BATES, KEVIN T	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 01/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,187

Applicant(s)

SOOBOK, LEE

Examiner

Kevin Bates

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-6 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-12-2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to a communication made on January 13, 2005.

The Supplementary Amendment was received on January 13, 2005.

The Information Disclosure Statement was received on December 12, 2001.

The Foreign Priority Papers were received on July 11, 2001.

Claims 1-9 are pending in this application.

Priority

This Application is currently receiving the priority date of January 11, 2000 because of the continuing application of PCT/KR00/00012. This application is not currently receiving the priority date of the foreign filing of January 13, 1999 because of it was not properly filed. The applicant must contact the PCT office concerning the improper filing of the foreign priority to obtain the foreign date.

Interview Summary

The examiner initiated an interview on January 10, 2005, and spoke with Carl Oppedahl about the allowability of the first section of claim 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen (6836792).

Regarding claim 1, Chen discloses an e-mail add-on system (Column 4, lines 3 – 5) comprising: a domain suffix e-mail address representation system including a syntax of a receiver mail address in form of "USERID@DOMAIN.suffix" having a domain suffix (.suffix) selected for an e-mail add-on service (Column 5, lines 41 - 43; Column 6, lines 48 - 54) and a series of definitions for meaning of the syntax, the domain suffix having a root domain suffix selected in formally registered domain names in the Internet and a supplementary domain suffix for limiting the add-on service represented by the root domain suffix (Column 6, lines 48 - 54; Column 7, lines 16 - 25); a relay-mode add-on service mail server installed to an Internet host having a "DOMAIN.suffix" type domain name for receiving a message having a "USERID@DOMAIN.suffix" type receiver e-mail address (Column 6, lines 54 – 58), the relay-mode add-on service mail server making a new message by processing the add-on source defined in the domain suffix e-mail address representation system and applying options of the add-on service according to contents of the root domain suffix and the supplementary domain suffix specified in ".suffix" (Column 6, lines 48 – 54), the relay-mode add-on service mail server then relaying the new message to an original receiver address "USERID@DOMAIN" (Column 7, lines 24 - 25); and a Meta domain name system including a Meta domain name database for showing a relation between a "DOMAIN.suffix" type domain name and an IP (Internet Protocol) address of a relay-mode mail server host in charge of the

add-on service designated by ".suffix" for the "DOMAIN" portion, and a domain name server software for providing the add-on service (Column 6, lines 48 – 58).

Regarding claim 2, Chen discloses that in the domain suffix e-mail address representation, the supplementary domain suffix has a syntax containing a variable parameter for flourishing the options of the add-on service; and wherein, the Meta domain name system, the Meta domain database and the Meta domain name server include the syntax containing a variable parameter (Column 6, lines 59 – Column 7, line 10).

Regarding claim 5, Chen discloses a message modifying relay-mode mail server for selecting a picture post-card designated by the domain suffix which the sender attaches at the end of the receiver address and modifying the mail message by applying the picture post-card to the mail message (Column 6, lines 10 – 18).

Regarding claim 6, Chen discloses a message modifying relay-mode mail server for modifying the mail message by interpreting and rewriting the mail message into a designated language according to an language interpretation instruction designated by the domain suffix which the sender attaches at the end of the receiver address (Column 7, lines 19 – 21).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Eggleston (6061660).

Regarding claim 4, Chen discloses a message modifying relay-mode mail server for adding a HTML tag containing information, does not explicitly indicate that the information is a lottery ticket issued or to be issued to the receiver and also maintaining a lottery win state database for each mail message. While Chen discloses adding advertisement banners in the form of a HTML tag, Eggleston discloses that banner advertisements have prizes and gifts associated with banner advertisements, sort of a lottery give away (Column 9, line 66 – Column 10, line 9) and a database that monitors the winners of those prizes and awards (Column 12, lines 12 – 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Eggleston's teaching of prizes associated with advertisements and banners as an incentive for clicking on those banners in Chen's system which obtains revenue by using banner advertisements (Column 1, lines 28 – 45).

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 7-9 are allowed.

Claims 3 and 7-9 are allowable over the prior art noted on the record because it discloses the additional idea of using different Meta top-level domain suffixes, ".to" and ".cc" in order to inform the system to perform the specific actions of transmitting a mail

read confirmation notification only to a sender and transmitting the mail read confirmation notification to other receivers except the sender, respectively.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent No. 6463462 issued to Smith, because it discloses an add on service at a relay server on the Internet that converts email messages to other formats based upon the requested actions.

U. S. Patent No. 5790790 issued to Smith, because it discloses a relay server that watches the status of email messages and gives the sender a database state of those messages.

U. S. Patent No. 6839738 issued to Quine, because it discloses a relay server that examines the domain and suffix of an email address.

U. S. Patent No. 6151624 issued to Teare, because it discloses a relay server that uses Metadata in an email address.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Bates whose telephone number is (571) 272-3980. The examiner can normally be reached on 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB

KB
January 25, 2005



HOSAIN ALAM
SUPERVISORY PATENT EXAMINER